DONALD R. ANTONELLI
MELVIN KRAUS
WILLIAM I. SOLOMON*
GREGORY E. MONTONE
RONALD J. SHORE
DONALD E. STOUT
ALAN E. SCHIAVELLI
CARL I. BRUNDIDGE*
PAUL J. SKWIERAWSKI*
HUNG H. BUI*
ALFRED A. STADNICKI*
*ADMITTED OTHER THAN VA

LAW OFFICES
ANTONELLI, TERRY, STOUT & KRAUS, LLP
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VIRGINIA 22209

TELEPHONE (703) 312-6600
FACSIMILE (703) 312-6666
email@antonelli.com

OF COUNSEL
DAVID T. TERRY
HAROLD A. WILLIAMSON*

FREDERICK D. BAILEY
RALPH T. WEBB*
STERLING W. CHANDLER*

PATENT AGENT
LARRY N. ANAGNOS

VIA FACSIMILE - 5 PAGES (Including This Cover)

Commissioner for Patents
POB 1450, Alexandria, VA 22313-1450
Transmitted to USPTO Central Fax No. 703-872-9306

Re: MAKI *et al.*, Serial No. 09/900,144
Att'y Docket 500.34077CC3
Ex. Mercader/AU 3737/USPTO Conf. No. 6500

SUBMISSION OF REQUEST FOR CORRECTED ACTION/RESTART

Sir:

Applicant hereby transmits the attached "REQUEST FOR CORRECTED OFFICE ACTION AND RESTART OF THE PERIOD FOR RESPONSE" (4 pages) regarding the above-identified application.

CERTIFICATE OF TRANSMISSION:

I hereby certify that the attached **"REQUEST FOR CORRECTED OFFICE ACTION AND RESTART OF THE PERIOD FOR RESPONSE" (4 pages)** is being **FORMALLY TRANSMITTED** *via* the USPTO Central Fax No. 703-872-9306 on **18 December 2003**.

Patricia J. Jaquett

#7
12/18

500.34077CC3/E2068-04EN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Atsushi MAKI *et al.*
Serial No.	:	09/900,144
Filed	:	9 July 2000
For	:	OPTICAL SYSTEM FOR MEASURING METABOLISM IN A BODY AND IMAGING METHOD
Art Unit	:	3737
Examiner	:	E.M. Mercader
Conf. No.	:	6500

REQUEST FOR CORRECTED OFFICE ACTION AND RESTART OF THE PERIOD FOR RESPONSE

Commissioner for Patents
POB 1450
Alexandria, Virginia 22313-1450

18 December 2003

Sir:

Applicant respectfully submits that the Office Action mailed 24 November 2003 in connection with the above-identified application is **defective**, for the following reasons.

Item 1 in the Office Action Summary indicates that the Action is "[r]esponsive to communication(s) filed 9 July 2001." Applicant presumes such communications must include the Preliminary Amendment submitted with the application, since Item 4 in the Summary indicates that Claims 1-46 are pending, and since Claims 39-46 are newly added in the application by the Preliminary Amendment. However, as indicated in the Preliminary Amendment, Claims 1-27 were cancelled from the present application. Therefore, It appears that the Preliminary Amendment was entered in part, was not entered or was not acted upon, since other matters

addressed in the Preliminary Amendment also have been ignored or not entered into the record. For instance, Applicant respectfully requested an Examiner Interview prior to the mailing of a first Action on the merits. Such request has been completely ignored in the 24 November Action. Further, the claim for priority under 35 USC §119 was made in the Preliminary Amendment, including a statement identifying the filing of both the certified copies of the priority documents and the verified English language translations thereof in the prior applications. However, Item 13 in the 24 November Action Summary indicates that none of the certified copies have been received to support Applicant's claim for priority under §119, and no acknowledgment of Applicant's domestic claim under §120 is made at all. Therefore, it again appears the Preliminary Amendment was not entered, or not entered in full, or not considered.

Furthermore, Applicant respectfully submits that the five (5) obviousness-type double patenting rejections, the sole rejections of the claims in the 24 November Action, also make the Action **defective** for the following reasons.

All five rejections indicate that Claims 1-46 (which all include cancelled Claims 1-27) are rejected over various patents issued on the prior applications upon which benefit is claimed under §120 in the present case, as well as are rejected over various patents for which a relation to the present application is not even made in the Action, although they have some common inventors or Assignees. All five rejections, using the exact same language in every one, merely state that, the claims of the present application are not patentably distinct from the claims in each patent, even though there are different numbers of claims in each, because "**they represent alternative variations and groupings**." Applicant **strongly** traverses

such repeated inadequate and improper excuse as grounds for rejection based on the following discussion.

Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, but also **requires** the same examination as is made for a rejection under §§102 and/or 103. The only difference between examination of claims for an obviousness-type double patenting rejection and for a §§102/103 rejection is that the claimed subject matter upon which rejection is based in double patenting cannot be applied as "prior art." More precisely, §MPEP 800 instructs that the conclusion of obviousness-type double patenting is made in light of **factual determinations**. Any obviousness-type double patenting rejection **should MAKE CLEAR the differences between the inventions** defined by the conflicting claims, and **the reasons why** a person of ordinary skill in the art would conclude that **the invention defined in the claims at issue is an obvious variation** of the invention defined in a claim in the patent.

Further, upon a merely cursory review of the alleged rejections, it was noted that at least one of the rejections is based on a prior patent upon which benefit is claimed under §120 (US 6,128,517). **In that prior application, original Claims 28-39, which are the precise same claims now pending in the present application, were cancelled as being withdrawn from consideration by an election of species** made with traverse on 27 July 1999 in response to a telephone request by Examiner Eric F. Winakur. Subsequently, Examiner Winakur made the election requirement of record in the Office Action mailed 14 September 1999 in that case. Therefore, even a cursory inspection of the alleged rejections reveals that

at least one of them is WHOLLY IMPROPER as a rejection of restricted claims under 35 USC §121. Accordingly, while the patents alleged in the rejections may be found by key word, class/subclass, Inventor or Assignee computer searches, it is *prima facie* obvious that no required analysis of the pending claims, no required comparison of claims at issue, and no proper grounds for the alleged rejections have been made.

Therefore, in accordance with 37 CFR §1.104, Applicant respectfully submits that **the Office Action is defective on multiple grounds**, and requests withdrawal of the 24 November Action and preparation of a proper replacement Action that includes complete treatment of any rejected claim based on valid grounds with the required analysis, and restart of the period for response as of the mailing date of any replacement Action.

This paper is being submitted within one month of the defective Action and with proper grounds, and therefore, under MPEP §710.06, such paper is timely filed and restart of the period for response is appropriate.

Respectfully submitted,

Paul J. Skwierawski
Registration No. 32,173
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209-3801, USA
Telephone 703-312-6600
Facsimile 703-312-6666